

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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8 *Ex parte* SUSAN G. KATZ  
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11 Appeal 2007-3309  
12 Application 10/647,618  
13 Technology Center 3600  
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16 Decided: November 26, 2007  
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20 *Before:* WILLIAM F. PATE, III, TERRY J. OWENS and  
21 STEVEN D.A. McCARTHY, *Administrative Patent Judges.*  
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23 McCARTHY, *Administrative Patent Judge.*

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25 DECISION ON APPEAL  
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27 STATEMENT OF THE CASE

28 The Appellant appeals under 35 U.S.C. § 134 (2002) from the final  
29 rejection of claims 1-12 and 14-23. We have jurisdiction under 35 U.S.C.  
30 § 6(b) (2002).

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1 Independent claim 1 is representative of the Appellant's claims and  
2reads as follows:

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1. A decorative external curtain assembly for  
applying fabric material to an external facade of a  
building, the assembly comprising:  
a sheet of fabric material;  
complementary engageable fastener strips  
for respectively fastening the fabric material to the  
external façade of the building; and  
an attachment arrangement for attaching one  
of the complementary engageable fastener strips to  
the building and another of the complementary  
engageable fastener strips to the fabric material;  
and  
wherein the complementary engageable  
fastener strips are made of a pair of strips, one strip  
having co-acting miniature hooks formed of a  
relatively rigid filament material and another of the  
strips having loops also formed of a relatively rigid  
filament material which engage one another to  
form a bond between the building and the fabric  
that is broken by pulling apart the pair of strips;  
and  
wherein the complementary engageable  
fastener strips fasten the fabric material to the  
external façade along an entire edge of the fabric  
material.

30The appealed claims are rejected under 35 U.S.C. § 103(a) as being  
31unpatentable over Hillstrom (U.S. Patent 5,040,586) in light of Phillips (U.S.  
32Patent 5,074,348).

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We affirm.

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1 ISSUE

2 The sole issue in this appeal is whether the Examiner erred in  
3contending that the substitution of hook-and-loop material as taught by  
4Phillips into a system for holding and displaying a banner as taught by  
5Hillstrom would have been obvious.

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7 FINDINGS OF FACT

8 The record supports the following findings of fact (“FF”) by a  
9preponderance of the evidence.

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11 1. Hillstrom discloses a system for holding and displaying a  
12banner on an exterior surface of a building. (Hillstrom, col. 1, ll. 5-7; col. 2,  
13ll. 55-68). The banner may be made from vinyl material, plastic material or  
14any “appropriate material.” (Hillstrom, col. 3, ll. 23-31). The parties do not  
15dispute the Examiner’s contention that the “appropriate material” for the  
16banner may be a sheet of fabric material. (See Office Action, Jan. 13, 2005  
17at 2). Hillstrom’s system uses a “frame device” which suspends the banner  
18on hooks between an extruded aluminum base member screwed or nailed  
19into the building surface and an extruded aluminum cover member biased  
20over the free ends of the hooks. (Hillstrom, col. 4, l. 59 –col. 5, l. 3 and col.  
214, ll. 8-14). Hillstrom states that the system “allows relatively quick and  
22easy changes of the banners.” (Hillstrom, col. 1, ll. 51-56).

23 2. The Examiner found that “Hillstrom discloses a banner attached  
24to the exterior of a building, the banner being made of ‘any appropriate  
25material,’ which clearly includes a fabric. The banner is removably attached  
26so that it can be changed easily, column 2 lined [*sic*, lines] 29-33. It is

1 attached to an eave at the roof line of a fast food restaurant. What is not  
2 shown are the hook and loop fasteners.” (Office Action, Jan. 13, 2005 at 2).  
3 Although the Appellant expressly agreed that “Hillstrom fails to disclose the  
4 use of hook and loop fasteners for attaching a banner to the exterior of a  
5 building” (Br. 6), the Appellant did not traverse the Examiner’s other  
6 findings as to the scope and content of Hillstrom.

7 3. Phillips teaches “a valance treatment for a window which is  
8 made of standard components both swags and jabot elements that can easily  
9 be mounted to suit almost any width of window.” (Phillips, col. 1, ll. 46-  
10 50). The swags are formed from textile materials. “Attachment strips”  
11 consisting of hook and loop tape are sewn across the top of each swag.  
12 (Phillips, col. 2, ll. 53-59; col. 3, ll. 1-2; and Fig. 4). The valance treatment  
13 is supported by a wood strip extending from a wall. A strip of hook-tape or  
14 loop-tape is attached to the top of the wood strip. The attachment strip sewn  
15 to the top edge of each swag is pressed against the hook-tape or loop-tape  
16 lying on the wood strip so that the swag folds over the exposed side of the  
17 wood strip. (Phillips, col. 3, ll. 8-24).

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## PRINCIPLES OF LAW

20 A claim is unpatentable for obviousness under 35 U.S.C. § 103(a) if  
21 “the differences between the subject matter sought to be patented and the  
22 prior art are such that the subject matter as a whole would have been obvious  
23 at the time the invention was made to a person having ordinary skill in the  
24 art to which said subject matter pertains.” In *Graham v. John Deere Co.*,  
25 383 U.S. 1 (1966), the Supreme Court set out factors to be considered in  
26 determining whether claimed subject matter would have been obvious:

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Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

14*Id.*, 383 U.S. at 17-18.

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In order to reject a claim under 35 U.S.C. § 103(a), an examiner must establish a “prima facie” case for obviousness. If the examiner rejects the claim, the applicant may submit arguments detailing reasons why the applicant believes the examiner failed to make a prima facie case. Once the examiner establishes a prima facie case, however, the claim is properly rejected unless the applicant submits evidence proving sufficient new facts such that the sum of the facts before the examiner does not to prove the claimed subject matter obvious. *See In re Dillon*, 919 F.2d 688, 692-93 (Fed. Cir. 1990) (*en banc*).

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An examiner cannot establish a prima facie case that a claim is obvious “merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Since not every combination of prior art references which happens to show each of the elements recited in a claim will suffice to establish a prima facie case for obviousness, the examiner must articulate reasons why the teachings of a particular combination suffice. That said, an

1examiner establishes a prima facie case that claimed subject matter is  
2obvious when the examiner articulates reasons consistent with the level of  
3ordinary skill in the art at the time of the invention why (in the words of 35  
4U.S.C. § 103(a)) “the differences between the subject matter sought to be  
5patented and the prior art are such that the subject matter as a whole would  
6have been obvious at the time the invention was made to a person having  
7ordinary skill in the art to which said subject matter pertains.”

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9 ANALYSIS

10 The first step in determining whether the Examiner has established a  
11prima facie case for obviousness is to determine the scope and content of the  
12prior art. With respect to claim 1, Hillstrom discloses a decorative external  
13curtain assembly for applying a sheet of an “appropriate material” to a wall.  
14The parties do not dispute that the Examiner’s contention that the  
15“appropriate material” could be a sheet of fabric material. (FF 1).

16 Phillips teaches complementary engageable fastener strips (namely,  
17hook-tape and loop-tape) sewn to a fabric material for engagement along an  
18entire edge of the fabric material. (FF 3). The limitation of claim 1:

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20 wherein the complementary engageable fastener  
21 strips are made of a pair of strips, one strip having  
22 co-acting miniature hooks formed of a relatively  
23 rigid filament material and another of the strips  
24 having loops also formed of a relatively rigid  
25 filament material which engage one another to  
26 form a bond between the building and the fabric  
27 that is broken by pulling apart the pair of strips  
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1merely describes the structure and predictable operation of such hook tape  
2and loop tape. The parties do not dispute the Examiner's contention that the  
3use of hot glue or another adhesive for attaching lightweight materials such  
4as hook-and-loop material to solid surfaces such as the external facades of  
5buildings was within the level of ordinary skill in the art. (See Office  
6Action, Sept. 22, 2005 at 2-3).

7       The second step in determining whether the Examiner has established  
8a prima facie case for obviousness is to ascertain the differences between the  
9prior art and the claims at issue. The only differences between Hillstrom's  
10system and the subject matter of claim 1 is that, in the assembly of claim 1, a  
11fastener strip of hook-and-loop material sewn across an entire edge of a  
12fabric material and another fastener strip adhered to the building surface are  
13used to fasten the fabric material to the building surface. (FF 2). The  
14fastener strips and their attachment arrangement are taught or suggested by  
15Phillips.

16       The third step in determining whether the Examiner has established a  
17prima facie case for obviousness is to resolve the level of ordinary skill in  
18the art. The factors which may be considered in determining the level of  
19ordinary skill include the teachings of the prior art references themselves;  
20the education and experience of the inventor; and the sophistication of the  
21technology. *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed.  
22Cir. 2007). The Appellant does not contest that hook-and-loop material  
23predictably creates temporary bonds which are easily broken by pulling  
24apart the hook and loop tapes. (Specification 3). The Appellant's  
25background suggests that one skilled in the art would have had  
26"considerable experience with regard to the use of textiles and fabrics as

1articles of manufacture” (Rule 132 Affidavit, Nov. 2, 2004, ¶ 2). Given this  
2level of experience and the well-known prevalence of hook-and-loop  
3material in garments and other textile products, one skilled in the art would  
4have recognized that hook-and-loop material could be used to fasten fabric  
5materials to substrates and that fabric materials fastened by hook-and-loop  
6material could be easily detached. (FF 4). Given the relatively  
7unsophisticated nature of the technology, one skilled in the art would have  
8had the capacity to use hook-and-loop material to hold and display a fabric  
9material against an external facade of a building.

10 The final step in determining whether the Examiner has established a  
11prima facie case of obviousness is to determine whether the Examiner  
12articulated reasons why the differences between the subject matter sought to  
13be patented and the prior art are such that the subject matter as a whole  
14would have been obvious to a person having ordinary skill in the art. The  
15reasons for combining the teachings of the prior art may arise from the  
16nature of the combination itself. For example, a simple substitution of one  
17known element for another according to a known method to obtain  
18predictable results is prima facie unpatentable. *KSR*, 127 S.Ct. at 1740.

19 In the present case, it would have been obvious to substitute hook-  
20and-loop material sewn to a fabric material for engagement along an entire  
21edge of the fabric material as taught by Phillips into a system for holding  
22and displaying the fabric material on an exterior building surface as taught  
23by Hillstrom. Phillips taught that hook-and-loop material could be used to  
24hang a sheet of fabric material indoors. Substituting the hook-and-loop  
25material of Phillips for the “frame device” of Hillstrom would not change  
26the manner in which the hook-and-loop material fastened the fabric material



1to the building surface—the substitution would merely move the hook-and-  
2loop material from an indoor location to an outdoor location. As such, the  
3results of the substitution would have been predictable. These reasons alone  
4suffice to establish a prima facie case that the subject matter of the claim 1  
5was obvious.

6       The Appellant argues that a passage in Hillstrom criticizing “known  
7systems and devices” as unreliable, particularly when “placed outdoors  
8where they are subject to high winds and other harsh conditions” (Hillstrom,  
9col.1, ll. 32-34) teaches away from the substitution of hook-and-loop  
10material for the “frame device” disclosed in Hillstrom. (Br. 8-9). The  
11Examiner correctly observed that Hillstrom does not criticize the use of  
12hook-and-loop material specifically to hold and display banners outdoors.  
13(Ans. 4-5). The Examiner also observed that substituting hook-and-loop  
14material as taught by Phillips for the “frame device” disclosed by Hillstrom  
15in an outdoor display would “render changing of the banner easier.” (Ans.  
163; *compare* Specification 3 (stating that hook-and-loop material creates  
17temporary bonds that are easily broken by pulling apart the hook-and-loop  
18strips) *with* Hillstrom, col. 5, ll. 41-63 (describing sequence of steps required  
19to change a banner held in Hillstrom’s “frame device.”)). Hillstrom does not  
20teach away from the claimed subject matter because the reference’s criticism  
21of “known systems and devices” is not specific enough to have discouraged  
22one skilled in the art motivated to use hook-and-loop material to simplify the  
23changing of outdoor banners.

24       The Appellant further argues that the claimed subject matter was  
25intended to address the problem of displaying a sheet of fabric material  
26outdoors and that the alleged unreliability of hook-and-loop material renders

1it unsuitable to solve this problem. In support of this argument, the  
2Appellant cites *In re Wright*, 848 F.2d 1216, 1219 (Fed. Cir. 1988) for the  
3proposition that “the question posed, is whether what the Appellant did  
4would have been obvious to one of ordinary skill in the art *attempting to*  
5*solve the problem upon which the inventor was working.*” (Br. 11 [emphasis  
6added]). This proposition does not represent the current state of the law. *In*  
7*re Translogic Tech., Inc.*, Appeal No. 2006-1192 slip op. at 18-19 (Fed. Cir.  
8Oct. 12, 2007); *see also In re Dillon*, 919 F.2d 688, 693 (Fed. Cir. 1990) (*en*  
9*banc*) (overruling *Wright* at least in part). The subject matter of claim 1  
10consists of known elements combined in a known manner yielding  
11predictable results. This rationale suffices to establish *prima facie*  
12obviousness.

13 The Appellant submitted a “Rule 132 Affidavit” declaring that, in the  
14Appellant’s experience,

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16 the idea that [hook-and-loop] tape could be  
17 effectively used to attach a curtain to the outside of  
18 a building where the curtain is subjected to harsh  
19 environmental conditions is unexpected because  
20 the general opinion in the art is that [hook-and-  
21 loop material] would form too weak a bond to  
22 effective [*sic*] hold the banner or curtain to the  
23 exterior of the building when harsh environmental  
24 conditions such as wind and rain are encountered  
25 by the exterior curtain.  
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27(*Id.*, ¶ 7). The Appellant’s opinion regarding the legal issue of whether the  
28differences between the claimed subject matter and the prior art would have  
29been obvious to a person having ordinary skill in the art is not evidence in  
30the case. *In re Lindell*, 385 F.2d 453, 456 (C.C.P.A. 1967). To the extent

1that the Appellant sought to offer opinion testimony regarding the level of  
2skill in the art or to establish “unexpected results” as secondary evidence of  
3non-obviousness, the Appellant’s opinion testimony does not overcome the  
4strong prima facie evidence proving the obviousness of claim 1. *See id.*;  
5*Leapfrog Enterps., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir.  
62007).

7       On the record before us, the Appellant has not rebutted the  
8Examiner’s prima facie case that the subject matter of representative claim 1  
9was obvious. Since the Appellant did not separately argue the patentability  
10of claims 3 and 6-21, those claims fall with claim 1.

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12                                   CONCLUSION OF LAW

13       On the record before us, the Appellant has not shown that the  
14Examiner erred in rejecting the claims 1, 3 and 6-21 as being unpatentable  
15over Hillstrom in light of Phillips.

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17                                   DECISION

18       The Examiner’s rejection of claims 1, 3 and 6-21 is affirmed.

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20                                   AFFIRMED

21JRG

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